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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,828	01/27/1999	JOHN S. HENDRICKS	02688.00008	7008
4372	7590	03/05/2007	EXAMINER	
ARENT FOX PLLC			HUTTON JR, WILLIAM D	
1050 CONNECTICUT AVENUE, N.W.			ART UNIT	PAPER NUMBER
SUITE 400			2176	
WASHINGTON, DC 20036				
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	03/05/2007		PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/237,828	HENDRICKS ET AL.	
	Examiner	Art Unit	
	Doug Hutton	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 December 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,19-25,30-44,46-55 and 80-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,19-25,30-44,46,48-55 and 80-112 is/are rejected.
- 7) Claim(s) 47 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 January 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20060928</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

Applicant's Response

In Applicant's Response dated 12/08/2006, Applicant amended Claims 1, 30, 80, 86, 92, 93, 95, 99, 103, and 109, and argued against all rejections previously set forth in the Office Action dated 09/08/2006.

Based on the examiner's review of the Office Action dated 09/08/2006, the amended claims and the cited prior art, all rejections previously set forth are withdrawn.

Presently, Claims 1, 19-25, 30-44, 46-55 and 80-112 are pending in the present application.

Information Disclosure Statement

A portion of the references cited in the Information Disclosure Statement filed 09/28/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because many of the references do not list the publication date for the reference. The examiner has not considered, and has lined through, that portion of the Information Disclosure Statement as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this Information Disclosure Statement or the submission of any missing elements will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

For any person who, in the future, reviews the prosecution history of the present application, that person should know:

1. **the present claims, and any future claims, recited in the this application may read on the references listed in the Information Disclosure Statement dated 09/28/2006; and**
2. **the examiner expresses no opinion whatsoever on the issue of whether the present claims of this application read on the references listed in the Information Disclosure Statement dated 09/28/2006, regardless of whether the examiner has initialed the references listed in the Information Disclosure Statement dated 09/28/2006.**

Claim Objections

Claim 1 is objected to because of the following informalities:

- The phrase "*an electronic book, the electronic book including components of digital data that represent information*" in Lines 2-3 should be amended to — ~~an electronic book, the electronic book including components of digital data that represent information~~ — because an "*electronic book*" inherently includes "*components of digital data that represent information*" in that an electronic book is made up of "digital data" having "components" that "represent information." Thus, the second phrase does not further limit the scope of the "*electronic book*" and is therefore unnecessary.

Claim 19 is objected to because of the following informalities:

- The phrase “*a show links menu, wherein when selected, the show links menu displays*” in Line 5 should be amended to — ~~a show-the~~ links menu, wherein when selected, the ~~show-links~~ menu displays — because that is how the element is previously identified in the claims (see Claim 1, Line 5).

Claim 20 is objected to because of the following informalities:

- The phrase “*wherein each component on a page of the electronic book may have one or more links to another component*” in Lines 1-2 should be amended to — wherein each component of actual text on a page of the electronic book may have one or more links to ~~another component~~ the additional components — because that is how the elements are previously identified in the claims (see Claim 1, Lines 4 and 6).

Claim 21 is objected to because of the following informalities:

- The phrase “*the links menu*” in Line 2 should be amended to — ~~the links-~~ link type menu — because that is how the element is previously identified in the claims (see Claim 19, Lines 5-6).
- The phrase “*all corresponding linked components that exist on a page being displayed are highlighted*” in Lines 3-4 should be amended to — all ~~corresponding linked components-~~ links of the selected link type that exist on a

displayed page of the electronic book being displayed are highlighted — so that the limitation more clearly describes the invention.

Claim 22 is objected to because of the following informalities:

- The phrase “*wherein the linked components are highlighted by displaying the linked components in a first color different from a second color for remaining information on the page*” in Lines 1-3 should be amended to — wherein the linked components-links of the selected link type are highlighted by displaying the linked components in a first color that is different from a second color for remaining information other colors on the displayed page of the electronic book — so that the limitation reads more clearly.

Claim 23 is objected to because of the following informalities:

- The phrase “*wherein the linked components are displayed in a font different from a font used to display the page*” in Lines 1-2 should be amended to — wherein the linked components-links of the selected link type are displayed in a font that is different from a font used to display the pageother fonts on the displayed page of the electronic book — so that the limitation reads more clearly.

Claim 24 is objected to because of the following informalities:

- The phrase “*wherein the linked components are highlighted by displaying the linked components in one of a bold typeface, an italics typeface, and underlined*”

in Lines 1-3 should be amended to — wherein the ~~linked components~~ links of the selected link type are highlighted by displaying the ~~linked components~~ links in one of a bold typeface, an italics typeface, and an underlined typeface — so that the limitation reads more clearly.

Claim 25 is objected to because of the following informalities:

- The phrase “*wherein a desired link is activated by selecting a desired highlighted component using a cursor and operating a select button*” in Lines 1-2 should be amended to — wherein a desired link is activated by selecting a desired highlighted component link from the displayed page of the electronic book using [[a]]the cursor and operating [[a]]the select button — so that the limitation reads more clearly.

Claim 30 is objected to because of the following informalities:

- The phrase “*identifying a first selectable text element that is a section of the actual text*” in Line 3 should be amended to — identifying a first selectable text element that is a section of [[the]]actual text — because the claim subsequently recites that other “*selectable text elements*” are identified and associated with “*electronic files*” (see Lines 7-8), and because “*actual text*” is not previously identified in the claim.
- The phrase “*associating a first electronic file with the first selectable text element, wherein the associating step creates a first electronic link*” in Lines 5-6 should be

amended to — associating a first an electronic file with the first selectable text element, wherein the associating step creates a first an electronic link — because the claim subsequently recites that other “selectable text elements” are identified and associated with “electronic files” (see Lines 7-8), and because the claim subsequently recites that other “electronic links” are created (see Lines 7-8).

- The phrase “*the repeated steps creating electronic links*” in Lines 7-8 should be amended to — ~~the repeated steps thereby creating multiple electronic links, each electronic link having a corresponding selectable text element and a corresponding electronic file~~ — so that the limitation clearly indicates that the repeated “*identifying*” and “*associating*” steps create multiple “electronic links,” each having a corresponding “selectable text element” and a corresponding “electronic file.”
- The phrase “*activating the first electronic link by selecting the first selectable text element, the activating step causing the first electronic file to be displayed*” in Lines 9-10 should be amended to — activating one of the first multiple electronic links by selecting the first corresponding selectable text element, ~~the activating step thereby causing the first associated~~ electronic file to be displayed — so that the limitation corresponds with the previous suggested amendments.
- As indicated in the following rejection under 35 U.S.C. 112, second paragraph, the fifth limitation of Claim 30 should be deleted.

Claim 32 is objected to because of the following informalities:

- The phrase “*wherein the electronic book unit, comprises*” in Line 1 should be amended to — wherein the electronic book unit[[,]] comprises — because the comma is unnecessary.
- The phrase “*selected electronic files*” in Line 2 should be amended to — selected associated electronic files — because that is how the element is previously identified (see Claim 30, Line 5).

Claim 33 is objected to because of the following informalities:

- The phrase “*wherein the first selectable text element*” in Lines 1-2 should be amended to — wherein one of the first selectable text elements — because multiple “*selectable text elements*” are previously recited in the claims (see Claim 30, Lines 3-8).
- The phrase “*wherein activation of the first link*” in Lines 2-3 should be amended to — wherein activation of the first corresponding electronic link — because multiple “*electronic links*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 34 is objected to because of the following informalities:

- The phrase “*wherein the first selectable text element*” in Lines 1-2 should be amended to — wherein one of the first selectable text elements — because

multiple “*selectable text elements*” are previously recited in the claims (see Claim 30, Lines 3-8).

- The phrase “*wherein activation of the first link*” in Lines 2-3 should be amended to — wherein activation of the first corresponding electronic link — because multiple “*electronic links*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 35 is objected to because of the following informalities:

- The phrase “*wherein the first selectable text element*” in Lines 1-2 should be amended to — wherein one of the first selectable text elements — because multiple “*selectable text elements*” are previously recited in the claims (see Claim 30, Lines 3-8).
- The phrase “*wherein the first electronic file*” in Lines 2-3 should be amended to — wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 36 is objected to because of the following informalities:

- The phrase “*includes an audio modules*” in Lines 1-2 should be amended to — includes an audio module[[s]] — so that the phrase is grammatically correct.
- The phrase “*wherein when the first link is activated*” in Line 2 should be amended to — wherein when the first corresponding electronic link is activated — because

multiple “*electronic links*” are previously recited in the claims (see Claim 30, Lines 3-8).

- The phrase “*the audio unit*” in Line 2 should be amended to — the audio unit module — because that is how the element is previously identified (see Line 2).

Claim 39 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file*” in Line 2 should be amended to — wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 42 is objected to because of the following informalities:

- The phrase “*wherein activating the first link*” in Line 1 should be amended to — wherein activating the first corresponding electronic link — because multiple “*electronic links*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 43 is objected to because of the following informalities:

- The phrase “*wherein the first electronic*” in Line 1 should be amended to — wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).
- The phrase “*a second location*” in Line 1 should be amended to — a second location — because a “first location” is not previously mentioned in the claims.

Claim 48 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file is displayed in an overlay on a page of the first electronic link having the selected first location*” in Lines 1-2 should be amended to — wherein, upon selection of one of the selectable text elements, the first corresponding electronic file is displayed ~~in an overlaying~~ on a page of the first electronic link-book having the selected first locationselectable text element — in order to more clearly and more accurately describe the invention.

Claim 49 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file is displayed side by side with a page of the first electronic link having the selected first selectable text element*” in Lines 1-2 should be amended to — wherein, upon selection of one of the selectable text elements, the first corresponding electronic file is displayed side by side with a page of the first electronic link-book having the selected first selectable text element — in order to more clearly and more accurately describe the invention.

Claim 50 is objected to because of the following informalities:

- The phrase “*the first selectable text element*” in Lines 2-3 (two occurrences) should be amended to —one of the first selectable text elements — because multiple “*selectable text elements*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 51 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file*” in Line 1 should be amended to —
wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 52 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file*” in Line 1 should be amended to —
wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 53 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file*” in Line 1 should be amended to —
wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 54 is objected to because of the following informalities:

- The phrase “*wherein the first electronic file*” in Line 1 should be amended to —
wherein the first corresponding electronic file — because multiple “*electronic files*” are previously recited in the claims (see Claim 30, Lines 3-8).

Claim 91 is objected to because of the following informalities:

- The phrase “*wherein the multiple third components*” in Lines 1-2 is objected to because “*third components*” are not previously mentioned in the claims.

Claim 92 is objected to because of the following informalities:

- The phrase “*an electronic book, the electronic book including components of digital data that represent information*” in Lines 2-3 should be amended to — an electronic book, ~~the electronic book including components of digital data that represent information~~ — because an “*electronic book*” inherently includes “*components of digital data that represent information*” in that an electronic book is made up of “*digital data*” having “*components*” that “*represent information*.”

Thus, the second phrase does not further limit the scope of the “*electronic book*” and is therefore unnecessary.

- The phrase “*links among the components of the digital data*” in Line 4 should be amended to — links among ~~[[the]]~~ components of the ~~digital data electronic book~~ — so that the limitation corresponds to the previously suggested amendment.

Claim 93 is objected to because of the following informalities:

- The phrase “*an electronic book, the electronic book including components of digital data that represent information*” in Lines 2-3 should be amended to — an electronic book, ~~the electronic book including components of digital data that represent information~~ — because an “*electronic book*” inherently includes

“*components of digital data that represent information*” in that an electronic book is made up of “digital data” having “components” that “represent information.”

Thus, the second phrase does not further limit the scope of the “*electronic book*” and is therefore unnecessary.

- The phrase “*links among the components of the digital data*” in Line 4 should be amended to — links among [[the]]components of the digital data electronic book — so that the limitation corresponds to the previously suggested amendment.

Claim 95 is objected to because of the following informalities:

- The phrase “*an electronic book, the electronic book including components of digital data that represent information*” in Lines 2-3 should be amended to — an electronic book, ~~the electronic book including components of digital data that represent information~~ — because an “*electronic book*” inherently includes “*components of digital data that represent information*” in that an electronic book is made up of “digital data” having “components” that “represent information.”

Thus, the second phrase does not further limit the scope of the “*electronic book*” and is therefore unnecessary.

- The phrase “*links among the components of the digital data*” in Line 4 should be amended to — links among [[the]]components of the digital data electronic book — so that the limitation corresponds to the previously suggested amendment.

- The phrase “*wherein the first components is located in the electronic book*” in Lines 5-6 should be amended to — wherein the first component[[s]] is located in the electronic book — so that the phrase is grammatically correct.

Claim 98 is objected to because of the following informalities:

- The phrase “*wherein the second component is an network site*” in Lines 6-7 should be amended to — wherein the second component is [[an]]a network site — so the limitation is grammatically correct.

Claim 99 is objected to because of the following informalities:

- The phrase “*a plurality of electronic books, the electronic books including components of digital data that represent information*” in Lines 2-3 should be amended to — a plurality of electronic books, ~~the electronic book including components of digital data that represent information~~ — because “electronic books” inherently include “components of digital data that represent information” in that electronic books are made up of “digital data” having “components” that “represent information.” Thus, the second phrase does not further limit the scope of the “electronic books” and is therefore unnecessary.
- The phrase “*wherein a link links among a first and a second component of digital data of a corresponding electronic book; wherein when the links are activated, a first component is linked to a second component*” in Lines 6-8 should be amended to — wherein ~~a link links among each of the plurality of links connects a first and a second component of digital data of~~ [[a]]the corresponding

electronic book[[;]] to a second component of additional information regarding the first component; wherein, when the plurality of links are activated, [[a]]the first components [[is]]are linked to [[a]]the second components — so that the limitation uses consistent terminology and so that the limitation reads more clearly.

Claim 100 is objected to because of the following informalities:

- The phrase “*wherein the links*” in Lines 1-2 should be amended to — wherein the plurality of links — so that the claims use consistent terminology

Claim 101 is objected to because of the following informalities:

- The phrase “*wherein the links*” in Lines 1-2 should be amended to — wherein the plurality of links — so that the claims use consistent terminology

Claim 102 is objected to because of the following informalities:

- The phrase “*in the electronic book data*” in Line 2 should be amended to — in the electronic book-data — so that the phrase corresponds to a previously suggested amendment.
- The phrase “*wherein the second component is located at a location where electronic books are orderable and purchasable*” in Lines 2-4 should be amended to — wherein the second component is located at a location where electronic books are orderable and purchasable — so that the phrase reads more clearly.

Claim 109 is objected to because of the following informalities:

- The phrase "*wherein the second component is selected from the group consisting of a product catalog, and a service catalog*" in Line 2 should be amended to — wherein the second component is selected from the group consisting of a product catalog[[,]] and a service catalog — so that it is clear that the "service catalog" is part of the recited "group."

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 92-95 and 98-100 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 92-95 and 98:

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

In summary, Claims 92, 93, 95 and 98 recite an electronic book system comprising an electronic book having components and links. The recited "electronic

book," "components" and "links" are simply electronic information. Also, the claims fail to recite any computer hardware. Thus, the recited invention is computer software *per se*.

A computer program is merely a set of instructions capable of being executed by a computer. The computer program itself is not a statutory process in that it does not include the computer-readable medium needed to realize the functionality of the computer program.

Additionally, Claims 92, 93, 95 and 98 fail to recite a tangible, real-world result in that no practical applications of the electronic book system are recited, such as displaying an electronic book on a computer monitor or transmitting an electronic book via a computer network.

Accordingly, as currently recited, Claims 92, 93, 95 and 98 are directed to an abstract idea that does not produce a concrete, useful and tangible result.

Claim 94 merely recites that the components are accessible via the Internet. Thus, Claim 94 fails to produce a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 99 and 100:

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

In summary, Claim 99 recites an electronic book system comprising a distant operation center and multiple electronic books having components and links. The recited "operation center," "electronic book," "components" and "links" are simply electronic information and/or software applications. Also, the claims fail to recite any computer hardware. Thus, the recited invention is computer software *per se*.

A computer program is merely a set of instructions capable of being executed by a computer. The computer program itself is not a statutory process in that it does not include the computer-readable medium needed to realize the functionality of the computer program.

Additionally, Claim 99 fails to recite a tangible, real-world result in that no practical applications of the electronic book system are recited, such as displaying an electronic book on a computer monitor or transmitting an electronic book via a computer network.

Accordingly, as currently recited, Claim 99 is directed to an abstract idea that does not produce a concrete, useful and tangible result.

Claim 100 merely recites that the components are purchasable separately from the electronic book. Thus, Claim 100 fails to produce a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 19-25, 80-85, 91 and 102-108 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1, 19-25, 91 and 102:

Claim 1 recites a “*first component*” that comprises “*actual text*” in an “*electronic book*” (see Line 4) and a “*second component*” that is a “*links menu*” to multiple “*additional components*” (see Lines 5-6). Claim 1 then recites that “*clicking on the first component . . . creates a link to the second component*” (see Lines 7-8). Stated differently, the “*link*” between the “*actual text*” and the “*links menu*” is created when the user clicks on the “*actual text*.”

The Specification of the present application does not describe the invention this way. That is, no link between the “*actual text*” and the “*links menu*” is created when the user clicks on the “*actual text*.¹ In fact, there is no “*link*” between the “*actual text*” and the “*links menu*” in the present invention.

Rather, there are only “*links*” between the “*actual text*” and the “*additional components*” (recited in Line 6), which comprise dictionary definitions of the “*actual text*” and other similar additional information about the text in the book. The user or the programmer manually creates these links, and the links are then automatically incorporated into the “*links menu*.² Thus, no “*link*” between the “*actual text*” and the “*links menu*” is created in the present invention.

The “*links menu*” provides a list of “*additional components*” for the “*actual text*.³ However, the “*links menu*” is displayed only when the user clicks on the “show links” button (see Figure 19). Thus, no “*link*” is created between the “*actual text*” and the “*links menu*” when the user clicks on the “*actual text*.⁴

Page 45, Lines 17-23 of the Specification states that, upon selection of a component (i.e., “*actual text*”) with underlying links (note that the “underlying links” were previously created, prior to the user clicking on the text in the electronic book), the linked material is displayed on the viewer. The “linked material” is the “*additional components*” (see Claim 1, Line 6), not the “*links menu*” (see Claim 1, Line 5).

For these reasons, Claims 1, 19-25, 91 and 102 contain subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 80-85:

Claim 80 also recites displaying a "*links menu*" in response to a selection of "*actual text*" in an electronic document. As stated in the above discussion for Claim 1, the present invention does not operate in this manner.

Thus, Claims 80-85 contain subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 103-108:

Claim 103 also recites displaying a "*links menu*" in response to a selection of "*actual text*" in an electronic document. As stated in the above discussion for Claim 1, the present invention does not operate in this manner.

Thus, Claims 103-108 contain subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30, 33-44 and 51-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30, 33-44 and 51-55:

Claim 30 recites "*activating the first electronic link by selecting the first selectable text element, the activating step causing the first electronic file to be displayed*" (see Lines 9-10) and "*providing a menu, wherein the menu includes a show links menu*" (see Line 11). Thus, the "*first electronic file*" recited in Line 10 appears to be the "*links menu*" recited in Line 11.

However, Claim 33 recites that the "*first selectable text element*" is a "*location in an index*" of the electronic book (see Lines 1-2) and that "*activation of the first link displays a page*" of the electronic book (see Lines 2-3). Thus, the "*first electronic file*" recited in Claim 30, Line 10 appears to be the "*page*" of the electronic book.

Accordingly, Claim 30 does not correspond with Claim 33, since the "*first electronic file*" appears to be the "*links menu*" according to Claim 30 and the "*first electronic file*" appears to be the "*page*" of the electronic book according to Claim 33.

The same analysis may be applied to Claims 34-44 and 51-55.

Accordingly, the scope of the claims is indefinite.

Applicant may obviate this rejection by deleting the fifth recited limitation from Claim 30. However, doing so will affect Claims 46 and 47, which appear to recite

further limitations of the “*links menu*” recited in the fifth limitation of Claim 30. If Applicant chooses to delete the fifth limitation from Claim 30, then Claims 46 and 47 should also be cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 30-34, 39, 40, 43, 44, 46, 48-50, 80-82, 85-91, 103 and 104 are rejected under 35 U.S.C. 102(b) as being anticipated by DeRose et al., U.S. Patent No. 5,557,722 (hereinafter, “DeRose”).

Claim 1:

DeRose discloses an *electronic book system* [see Column 1, Lines 13-20 → DeRose discloses this limitation, as clearly indicated in the cited text], *comprising*:

- *an electronic book, the electronic book including components of digital data that represent information* [see Figures 3-6, 12-15 and 22 → DeRose discloses this limitation, as clearly indicated in the cited figures. Moreover, an “*electronic book*” inherently includes “*components of digital data that represent information*” in that an electronic book is made up of “*digital data*” having “*components*” that “*represent information*.”];

- *a first component of actual text of the electronic book [see Figures 12 and 14; see Column 15, Lines 43-47 → DeRose discloses this limitation in that the electronic book comprises a table of contents];*
- *a second component, wherein the second component is a links menu to a plurality of additional components [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system displays that section and icons for the annotations of that section],*

wherein the first component is configured such that clicking on the first component of actual text of the electronic book creates a link to the second component [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system retrieves that section and the annotations associated with that section. The system subsequently displays the selected section and icons for the annotations associated with that section.].

Claim 30:

DeRose discloses a *method for linking electronic files to electronic books [see Figure 22 → DeRose discloses this limitation, as clearly indicated in the cited figure], comprising:*

- *identifying a first selectable text element that is a section of the actual text in a first electronic book [see Figures 12 and 14; see Column 15, Lines 43-47 → DeRose discloses this limitation in that the electronic book comprises a table of contents including user-selectable sections of the electronic book];*
- *associating a first electronic file with the first selectable text element, wherein the associating step creates a first electronic link [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system retrieves that section and the annotations associated with that section. The system subsequently displays the selected section and icons for the annotations associated with that section.];*
- *repeating the identifying and associating steps, the repeated steps creating electronic links [DeRose discloses this limitation in that, as indicated in the previous discussion, the system retrieves every annotation associated with the selected section];*
- *activating the first electronic link by selecting the first selectable text element, the activating step causing the first electronic file to be displayed [see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that the system displays one of the annotations associated with the selected section when the user clicks on the corresponding icon]; and*
- *providing a menu, wherein the menu includes a show links menu, and wherein the show links menu displays all available electronic links associated with a*

selected selectable text element in the first electronic link [DeRose discloses this limitation in that, as indicated in the previous discussion, the system retrieves and displays every annotation associated with the selected section].

Claim 31:

DeRose discloses *the method of Claim 30, wherein the electronic books are stored in an electronic book unit [see Figure 1, element 30].*

Claim 32:

DeRose discloses *the method of Claim 31, wherein the electronic book unit, comprises:*

- *a memory that stores the electronic books and selected electronic files [see Figure 1, element 34];*
- *a display that displays the electronic books and the electronic files [see Figure 1, element 36];*
- *a control unit adapted to receive commands from a user [see Figure 1, element 32]; and*
- *a controller that controls operation of the electronic book unit and activation of the electronic links [see Figure 1, element 32].*

Claim 33:

DeRose discloses *the method of Claim 30, wherein the first selectable text element is a location in an index of the first electronic book, wherein activation of the first link displays a page of the first electronic book associated with the location in the index* [see Figures 12 and 13; see Column 17, Lines 27-43 → DeRose discloses this limitation in that the system allows the user to search for a particular word within the document using a lookup window. The system then displays the table of contents and indicates how many times the search word appears in the various sections of the table of contents. This is the equivalent of the recited “*index*.” The user may then click on a relevant section of the table of contents to display the relevant section].

Claim 34:

DeRose discloses *the method of Claim 30, wherein the first selectable text element is a location in a table of contents of the first electronic book, and wherein activation of the first link displays a page of the first electronic book associated with the location in the table of contents* [see Figures 12 and 14; see Column 15, Lines 43-47 → DeRose discloses this limitation in that the system allows the user to select a section of the document within a table of contents and displays the selected section].

Claim 39:

DeRose discloses *the method of Claim 30, wherein the electronic book unit is connected to a telecommunications network, and wherein the first electronic file is*

stored in a database in the telecommunications network [see Column 24, Lines 29-40

→ DeRose discloses this limitation in that the system operates on a computer network that allows the electronic books, and their associated elements, to be shared].

Claim 40:

DeRose discloses *the method of Claim 39, wherein the telecommunications network includes one of a telephone system, a cable television system, a wireless telephone system, a digital satellite television system, a fiber optic system, an Ethernet, and a wireless television system [see Column 24, Lines 29-40* → DeRose discloses this limitation in that the system operates on a computer network that allows the electronic books, and their associated elements, to be shared. This disclosure implies, at a minimum, that the “network” included a “telephone system” in that such networks included telephone modems and systems that enabled electronic information to be transferred].

Claim 43:

DeRose discloses *the method of Claim 30, wherein the first electronic is a second location in a second electronic book [see Column 8, Lines 17-24* → DeRose discloses this limitation in that the system comprises cross-references that link relevant sections of separate documents].

Claim 44:

DeRose discloses *the method of Claim 43, wherein the first and the second electronic books are stored in an electronic book unit [see Figure 1, element 30].*

Claim 46:

DeRose discloses *the method of Claim 30, wherein a desired electronic link is selected from the displayed available electronic links [see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that the system displays one of the annotations associated with the selected section when the user clicks on the corresponding icon].*

Claim 48:

DeRose discloses *the method of Claim 30, wherein the first electronic file is displayed in an overlay on a page of the first electronic link having the selected first location [see Figures 12-14; see Column 3, Lines 27-50; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation, as clearly indicated in the cited figures and text].*

Claim 49:

DeRose discloses *the method of Claim 30, wherein the first electronic file is displayed side by side with a page of the first electronic link having the selected first selectable text element [see Figures 12-14; see Column 3, Lines 27-50; see Column 22,*

Line 63 through Column 23, Line 36 → DeRose discloses this limitation, as clearly indicated in the cited figures and text].

Claim 50:

DeRose discloses *the method of Claim 30, wherein the activating step comprises operating a pointing device and a cursor to highlight the first selectable element and operating a select button to select the first selectable text element* [see Column 15, Lines 37-47 → DeRose discloses this limitation, as clearly indicated in the cited text].

Claim 80:

This claim corresponds to the subject matter recited in Claims 1 and 30. Thus, DeRose discloses every limitation of Claim 80, as indicated in the above rejections for Claims 1 and 30.

Claim 81:

This claim corresponds to the subject matter recited in Claim 34. Thus, DeRose discloses every limitation of Claim 81, as indicated in the above rejection for Claim 34.

Claim 82:

This claim corresponds to the subject matter recited in Claim 43. Thus, DeRose discloses every limitation of Claim 82, as indicated in the above rejection for Claim 43.

Claim 85:

This claim corresponds to the subject matter recited in Claim 34. Thus, DeRose discloses every limitation of Claim 85, as indicated in the above rejection for Claim 34.

Claim 86:

This claim corresponds to the subject matter recited in Claim 30. Thus, DeRose discloses every limitation of Claim 86, as indicated in the above rejection for Claim 30.

Claim 87:

This claim corresponds to the subject matter recited in Claim 30. Thus, DeRose discloses every limitation of Claim 87, as indicated in the above rejection for Claim 30.

Claim 88:

This claim corresponds to the subject matter recited in Claim 30. Thus, DeRose discloses every limitation of Claim 88, as indicated in the above rejection for Claim 30.

Claim 89:

DeRose discloses *the method of Claim 86, wherein the created link provides access from the selected additional content to the selected content associated with the electronic book* [see Column 15, Lines 43-56 → DeRose discloses this limitation in that the text of the electronic books contain cross-references that allow the user to flip back and forth between the linked cross-referenced elements of the books].

Claim 90:

DeRose discloses *the method of Claim 86, wherein the created link is a two-way link* [see Column 15, Lines 43-56 → DeRose discloses this limitation in that the text of the electronic books contain cross-references that allow the user to flip back and forth between the linked cross-referenced elements of the books].

Claim 91:

DeRose discloses *the method of Claim 1, wherein the multiple third components relate to the information represented by the first component* [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system retrieves that section and the annotations associated with that section. The system subsequently displays the selected section and icons for the annotations associated with that section. Additionally, the system displays the annotations when the corresponding icons are clicked upon by the user.].

Claim 103:

This claim corresponds to the subject matter recited in Claim 30. Thus, DeRose discloses every limitation of Claim 103, as indicated in the above rejection for Claim 30.

Claim 104:

This claim corresponds to the subject matter recited in Claims 30 and 91. Thus, DeRose discloses every limitation of Claim 104, as indicated in the above rejection for Claims 30 and 91.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 36, 51, 52, 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Reed et al., U.S. Patent No. 5,241,671 (hereinafter, "Reed").

Claim 35:

As indicated in the above discussion, DeRose discloses every limitation of Claim 30.

DeRose fails to expressly disclose:

- *[a] first selectable text element [that] is one of a word and a phrase in the first electronic book; and*

- *[a] first electronic file [that] is a location in a dictionary that defines the word or phrase.*

Reed teaches a computer search system for retrieving textual information from a database [see Column 1, Lines 8-11 → Reed teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first selectable text element [that] is one of a word and a phrase in the first electronic book [see Column 11, Line 53 through Column 12 Line 2 → Reed teaches this limitation in that the system displays an electronic document and allows the user to click on a word in the document]; and*
- *[a] first electronic file [that] is a location in a dictionary that defines the word or phrase [see Column 11, Line 53 through Column 12 Line 2 → Reed teaches this limitation in that, upon the user clicking on the word, the system displays a dictionary definition for the word],*

for the purpose of defining words in the electronic document for the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first selectable text element [that] is one of a word and a phrase in the first electronic book; and*
- *[a] first electronic file [that] is a location in a dictionary that defines the word or phrase,*

for the purpose of defining words in the electronic document for the user, as taught in Reed.

Claim 36:

DeRose fails to expressly disclose:

- *[an] electronic book unit [that] includes an audio modules, wherein when the first link is activated, the audio unit provides an audio presentation giving a pronunciation of the word or phrase.*

Reed teaches a computer search system for retrieving textual information from a database [see Column 1, Lines 8-11 → Reed teaches this limitation, as clearly indicated in the cited text], comprising:

- *[an] electronic book unit [that] includes an audio modules, wherein when the first link is activated, the audio unit provides an audio presentation giving a pronunciation of the word or phrase [see Column 11, Line 53 through Column 12 Line 11 → Reed teaches this limitation in that the system displays an electronic document and allows the user to click on a word in the document. Upon the user clicking on the word, the system gives an audio pronunciation of the word],*

for the purpose of demonstrating the correct pronunciation of words in the electronic document for the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[an] electronic book unit [that] includes an audio modules, wherein when the first link is activated, the audio unit provides an audio presentation giving a pronunciation of the word or phrase,*

for the purpose of demonstrating the correct pronunciation of words in the electronic document for the user, as taught in Reed.

Claim 51:

DeRose fails to expressly disclose:

- *[a] first electronic file [that] is an audio presentation.*

Reed teaches a computer search system for retrieving textual information from a database [see Column 1, Lines 8-11 → Reed teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first electronic file [that] is an audio presentation [see Column 11, Line 53 through Column 12 Line 11 → Reed teaches this limitation in that the system displays an electronic document and allows the user to click on a word in the document. Upon the user clicking on the word, the system gives an audio pronunciation of the word],*

for the purpose of demonstrating the correct pronunciation of words in the electronic document for the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first electronic file [that] is an audio presentation,*

for the purpose of demonstrating the correct pronunciation of words in the electronic document for the user, as taught in Reed.

Claim 52:

DeRose fails to expressly disclose:

- *[a] first electronic file [that] is an video presentation.*

Reed teaches a computer search system for retrieving textual information from a database [see Column 1, Lines 8-11 → Reed teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first electronic file [that] is an video presentation [see Column 13, Lines 21-25
→ Reed teaches this limitation in that the system displays videos associated with
the text of an electronic document],*

for the purpose of displaying to the user additional information related to the electronic document.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first electronic file [that] is an video presentation,*

for the purpose of displaying to the user additional information related to the electronic document, as taught in Reed.

Claim 83:

This claim corresponds to the subject matter recited in Claims 36 and 51. Thus, DeRose, in view of Reed, discloses/teaches every limitation of Claim 83 and provides proper motivation, as indicated in the above rejections for Claims 36 and 51.

Claim 84:

This claim corresponds to the subject matter recited in Claims 36, 51 and 52. Thus, DeRose, in view of Reed, discloses/teaches every limitation of Claim 84 and provides proper motivation, as indicated in the above rejections for Claims 36, 51 and 52.

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Reed, and further in view of Munyan, U.S. Patent No. 5,761,485 (hereinafter, "Munyan").

Claim 37:

As indicated in the above discussion, DeRose, in view of Reed, discloses/teaches every limitation of Claim 35.

DeRose, in view of Reed, fails to expressly disclose/teach:

- *[a] dictionary [that] is a foreign language dictionary; and*
- *[an] electronic file [that] is displayed in a foreign language.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] dictionary [that] is a foreign language dictionary* [see Column 7, Lines 16-24; see Column 10, Lines 34-40 → Munyan teaches this limitation in that the system comprises electronic books written in foreign languages and preloaded dictionaries that enable a user to look up the meaning of words]; and
- *[an] electronic file [that] is displayed in a foreign language* [see Column 10, Lines 34-40 → Munyan teaches this limitation in that the system comprises electronic books written in foreign languages],

for the purpose of defining words in the electronic book for the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed/taught in DeRose, in view of Reed, to include:

- *[a] dictionary [that] is a foreign language dictionary; and*
- *[an] electronic file [that] is displayed in a foreign language,*

for the purpose of defining words in the electronic book for the user, as taught in Munyan.

Claim 38:

As indicated in the above discussion, DeRose, in view of Reed, discloses/teaches every limitation of Claim 35.

DeRose, in view of Reed, fails to expressly disclose/teach:

- *[an] electronic book unit [that] activates a selected foreign language selection feature; and*
- *[an] electronic book unit [that] activates a selected foreign language dictionary based on an input from the foreign language selection feature.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

Art Unit: 2176

- *[an] electronic book unit [that] activates a selected foreign language selection feature* [see Column 10, Lines 34-40 → Munyan teaches this limitation in that the system allows the user to access a foreign language bookstore]; and
- *[an] electronic book unit [that] activates a selected foreign language dictionary based on an input from the foreign language selection feature* [see Column 7, Lines 16-24; see Column 10, Lines 34-40 → Munyan teaches this limitation in that the system comprises electronic books written in foreign languages and preloaded dictionaries that enable a user to look up the meaning of words], for the purpose of allowing a user to view electronic books written in foreign languages and defining words in the electronic books for the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed/taught in DeRose, in view of Reed, to include:

- *[an] electronic book unit [that] activates a selected foreign language selection feature; and*
 - *[an] electronic book unit [that] activates a selected foreign language dictionary based on an input from the foreign language selection feature.*
- for the purpose of allowing a user to view electronic books written in foreign languages and defining words in the electronic books for the user, as taught in Munyan.

Claims 41, 42, 93, 94, 99, 106 and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Reynolds et al., U.S. Patent No. 6,052,717 (hereinafter, "Reynolds").

Claim 41:

As indicated in the above discussion, DeRose discloses every limitation of Claim 39.

DeRose fails to expressly disclose:

- *[a] database [that] is part of an Internet web site.*

Reynolds teaches an interactive Web book system [see Column 2, Lines 24-26
→ Reynolds teaches this limitation, as clearly indicated in the cited text], comprising:

- *an electronic book unit [that] is connected to a telecommunications network* [see Column 2, Line 56 through Column 3, Line 16 → Reynolds teaches this limitation in that the system includes electronic books and additional content, all of which are part of the Internet];
- *a first electronic file [that] is stored in a database in the telecommunications network* [see Column 3, Line 27 through Column 5, Line 2 → Reynolds teaches this limitation in that the system allows users to contribute additional content to the electronic books. The additional content is linked to the corresponding electronic book and stored on servers connected to the Internet];

Art Unit: 2176

wherein the database is a part of an Internet web site [see Column 3, Line 27 through Column 5, Line 2 → Reynolds teaches this limitation in that the system allows users to contribute additional content to the electronic books. The additional content is linked to the corresponding electronic book and stored on servers connected to the Internet], for the purpose of allowing users to contribute additional information to electronic books.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] database [that] is part of an Internet web site,* for the purpose of allowing users to contribute additional information to electronic books, as taught in Reynolds.

Claim 42:

DeRose fails to expressly disclose:

- *activating the first link provides access to the Internet web site.*

Reynolds teaches an interactive Web book system [see Column 2, Lines 24-26 → Reynolds teaches this limitation, as clearly indicated in the cited text], *wherein activating [a] first link provides access to the Internet web site* [see Column 3, Line 27 through Column 5, Line 2 → Reynolds teaches this limitation in that the system allows

users to view the contributed additional content of the electronic books by clicking on links in the electronic book],
for the purpose of allowing users to view the contributed additional information to electronic books.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *activating the first link provides access to the Internet web site,*
for the purpose of allowing users to contribute additional information to electronic books, as taught in Reynolds.

Claim 93:

This claim corresponds to the subject matter recited in Claims 41 and 42. Thus, DeRose, in view of Reynolds, discloses/teaches every limitation of Claim 93 and provides proper motivation, as indicated in the above rejections for Claims 41 and 42.

Claim 94:

This claim corresponds to the subject matter recited in Claims 41 and 42. Thus, DeRose, in view of Reynolds, discloses/teaches every limitation of Claim 94 and provides proper motivation, as indicated in the above rejections for Claims 41 and 42.

Claim 99:

DeRose discloses an *electronic book distribution system* [see Column 1, Lines 13-20 → DeRose discloses this limitation, as clearly indicated in the cited text], comprising:

- a data repository [see Figure 1, elements 30 and 34] that is configured to store:
 - a *plurality of electronic books, the electronic books including components of digital data that represent information* [see Figures 3-6, 12-15 and 22; see Column 8, Lines 17-24 → DeRose discloses this limitation, as clearly indicated in the cited figures and text. Moreover, an “*electronic book*” inherently includes “*components of digital data that represent information*” in that an electronic book is made up of “*digital data*” having “*components*” that “*represent information*.”]; and
 - a *plurality of links corresponding to at least one of the plurality of electronic books* [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that the electronic book comprises a table of contents, and, when a user clicks on a section of the electronic book in the table of contents, the system displays that section and icons for the annotations of that section], *wherein a link links among a first and a second component of digital data of a corresponding electronic book* [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the

system retrieves that section and the annotations associated with that section.

The system subsequently displays the selected section and icons for the annotations associated with that section.]; *wherein when the links are activated, a first component is linked to a second component* [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system retrieves that section and the annotations associated with that section. The system subsequently displays the selected section and icons for the annotations associated with that section.].

DeRose fails to expressly disclose:

- *a distant operation center,*

wherein the operation center is configured to allow the selection and distribution of links separate from the electronic book to which it corresponds.

Reynolds teaches an interactive Web book distribution system [see Column 2, Lines 24-26 → Reynolds teaches this limitation, as clearly indicated in the cited text], comprising:

- *a distant operation center [storing a plurality of books and links among first and second components of the books]* [see Column 2, Line 56 through Column 5, Line 2 → Reynolds teaches this limitation in that the system allows users to contribute additional content to the electronic books via the Internet (i.e., the

"distant operation center"). The additional content is linked to the corresponding electronic book and stored on servers connected to the Internet], wherein the operation center is configured to allow the selection and distribution of links separate from the electronic book to which it corresponds [see Column 3, Line 27 through Column 11, Line 49 → Reynolds discloses this limitation in that the system stores the additional content on web pages that are separate from the electronic book], for the purpose of distinguishing the various items of additional content for the electronic books.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in DeRose, to include:

- *a distant operation center,*
wherein the operation center is configured to allow the selection and distribution of links separate from the electronic book to which it corresponds,
for the purpose of distinguishing the various items of additional content for the electronic books, as taught in Reynolds.

Claim 106:

This claim corresponds to the subject matter recited in Claim 93. Thus, DeRose, in view of Reynolds, discloses/teaches every limitation of Claim 106 and provides proper motivation, as indicated in the above rejections for Claim 93.

Claim 107:

This claim corresponds to the subject matter recited in Claim 94. Thus, DeRose, in view of Reynolds, discloses/teaches every limitation of Claim 107 and provides proper motivation, as indicated in the above rejections for Claim 94.

Claims 53-55, 92, 102 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Munyan.

Claim 53:

As indicated in the above discussion, DeRose discloses every limitation of Claim 30.

DeRose fails to expressly disclose:

- *[a] first electronic file [that] is a location where products can be ordered and purchased.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first electronic file [that] is a location where products can be ordered and purchased* [see Column 9, Lines 39-54 → Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books],

for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first electronic file [that] is a location where products can be ordered and purchased,*

for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.

Claim 54:

DeRose fails to expressly disclose:

- *[a] first electronic file [that] is a location where books can be ordered and purchased.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first electronic file [that] is a location where books can be ordered and purchased* [see Column 9, Lines 39-54 → Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books],

for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first electronic file [that] is a location where books can be ordered and purchased,*

for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.

Claim 55:

DeRose fails to expressly disclose:

- *[a] first electronic file [that] is a location where electronic books can be ordered and purchased.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] first electronic file [that] is a location where electronic books can be ordered and purchased [see Column 9, Lines 39-54 → Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books],*

for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in DeRose, to include:

- *[a] first electronic file [that] is a location where electronic books can be ordered and purchased,*

for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.

Claim 92:

This claim corresponds to the subject matter recited in Claims 53-55. Thus, DeRose, in view of Munyan, discloses/teaches every limitation of Claim 92 and provides proper motivation, as indicated in the above rejections for Claims 53-55.

Claim 102:

This claim corresponds to the subject matter recited in Claims 53-55. Thus, DeRose, in view of Munyan, discloses/teaches every limitation of Claim 102 and provides proper motivation, as indicated in the above rejections for Claims 53-55.

Claim 105:

This claim corresponds to the subject matter recited in Claim 92. Thus, DeRose, in view of Munyan, discloses/teaches every limitation of Claim 105 and provides proper motivation, as indicated in the above rejections for Claim 92.

Claims 95-97, 100, 101 and 109-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Reynolds, and further in view of Munyan.

Claim 95:

DeRose discloses *an electronic book system* [see Column 1, Lines 13-20 → DeRose discloses this limitation, as clearly indicated in the cited text], *comprising:*

- *an electronic book, the electronic book including components of digital data that represent information* [see Figures 3-6, 12-15 and 22 → DeRose discloses this limitation, as clearly indicated in the cited text. Moreover, an “electronic book” inherently includes “components of digital data that represent information” in that an electronic book is made up of “digital data” having “components” that “represent information.”]; and
- *links among the components of the digital data* [see Column 8, Lines 17-24 → DeRose discloses this limitation in that the system comprises cross-references that link relevant sections of separate documents];

wherein when the links are activated, a first component is linked to a second component [see Column 8, Lines 17-24 → DeRose discloses this limitation in that, when a user clicks on a cross-reference, the system displays the cross-referenced documents]; *wherein the first components is located in the electronic book* [see Column 8, Lines 17-24 → DeRose discloses this limitation in that the cross-references are located in the electronic books]; and *wherein the second component is located in a data repository* [see Figure 1, element 34], *the data repository including a list of available books related to the first component* [see Figure 1, element 34 → DeRose discloses this limitation in that the mass storage device stores all of the electronic books of the system].

DeRose fails to expressly disclose:

- *[a] second component [that] is located in a distant data repository.*

Reynolds teaches an interactive Web book system [see Column 2, Lines 24-26 → Reynolds teaches this limitation, as clearly indicated in the cited text], comprising:

- *[a] second component [that] is located in a distant data repository* [see Column 3, Line 27 through Column 5, Line 2 → Reynolds teaches this limitation in that the system allows users to contribute additional content to the electronic books. The additional content is linked to the corresponding electronic book and stored on servers connected to the Internet], for the purpose of allowing users to contribute additional information to electronic books.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in DeRose, to include:

- *[a] second component [that] is located in a distant data repository,*

for the purpose of allowing users to contribute additional information to electronic books, as taught in Reynolds.

DeRose, in view of Reynolds, fails to expressly disclose/teach:

- ordering at least one of the books for delivery.

Munyan teaches an electronic book system [see Column 1, Lines 6-15 → Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- ordering at least one of the books for delivery [see Column 9, Lines 39-54 →

Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books],

for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed/taught in DeRose, in view of Reynolds, to include:

- ordering at least one of the books for delivery,

for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.

Claim 96:

DeRose, in view of Reynolds, fails to expressly disclose/teach:

- *electronic books [that] are [ordered and] delivered by transmission via a telecommunications system.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 →
Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *electronic books [that] are [ordered and] delivered by transmission via a telecommunications system* [see Column 9, Lines 39-54 → Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books],

for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed/taught in DeRose, in view of Reynolds, to include:

Art Unit: 2176

- *electronic books [that] are [ordered and] delivered by transmission via a telecommunications system,*

for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.

Claim 97:

Munyan teaches [an] electronic book system, *wherein the telecommunications network is selected from a group consisting of a publicly switched telephone network, a cable television system, a wireless telephone system, a digital satellite television system, a fiber optic system, an Ethernet network, and a wireless television system* [see Column 9, Lines 39-54 → Munyan teaches this limitation in that the system comprises an online bookstore through which users may purchase and download electronic books].

Claim 100:

As indicated in the above discussion, DeRose, in view of Reynolds, discloses/teaches every limitation of Claim 99 and provides proper motivation.

DeRose, in view of Reynolds, fails to expressly disclose/teach:

- *links [that] are purchasable separately from the electronic book.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 →
Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

- *links [that] are purchasable separately from the electronic book* [see Column 10,
Lines 41-62 → Munyan teaches this limitation in that the system comprises
subscription services for online publications],

for the purpose of providing easy and timely accessibility to new publications (see
Column 4, Lines 43-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at
the time the invention was made to modify the system, disclosed/taught in DeRose, in
view of Reynolds, to include:

- *links [that] are purchasable separately from the electronic book,*

for the purpose of providing easy and timely accessibility to new publications, as taught
in Munyan.

Claim 101:

DeRose, in view of Reynolds, fails to expressly disclose/teach:

- *links [that] are transmitted separately from delivery of the electronic book.*

Munyan teaches an electronic book system [see Column 1, Lines 6-15 →
Munyan teaches this limitation, as clearly indicated in the cited text], comprising:

Art Unit: 2176

- *links [that] are transmitted separately from delivery of the electronic book [see Column 10, Lines 41-62 → Munyan teaches this limitation in that the system comprises subscription services for online publications], for the purpose of providing easy and timely accessibility to new publications (see Column 4, Lines 43-45).*

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed/taught in DeRose, in view of Reynolds, to include:

- *links [that] are transmitted separately from delivery of the electronic book, for the purpose of providing easy and timely accessibility to new publications, as taught in Munyan.*

Claim 109:

This claim corresponds to the subject matter recited in Claims 99-101. Thus, DeRose, in view of Herz, and further in view of Munyan, discloses/teaches every limitation of Claim 109 and provides proper motivation, as indicated in the above rejections for Claims 99-101.

Claim 110:

This claim corresponds to the subject matter recited in Claims 99-101. Thus, DeRose, in view of Herz, and further in view of Munyan, discloses/teaches every limitation of Claim 110 and provides proper motivation, as indicated in the above rejections for Claims 99-101.

Claim 111:

This claim corresponds to the subject matter recited in Claims 99-101. Additionally, DeRose discloses “refreshing” links between the “first components” and the “second components” in that users may add annotations to the electronic books [see Column 22, Line 63 through Column 24, Line 28].

Thus, DeRose, in view of Herz, and further in view of Munyan, discloses/teaches every limitation of Claim 110 and provides proper motivation, as indicated in the above rejections for Claims 99-101.

Claim 112:

This claim corresponds to the subject matter recited in Claims 99-101. Thus, DeRose, in view of Herz, and further in view of Munyan, discloses/teaches every limitation of Claim 112 and provides proper motivation, as indicated in the above rejections for Claims 99-101.

Claims 98 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeRose, in view of Herz, U.S. Patent No. 6,460,036 (hereinafter, "Herz").

Claim 98:

DeRose discloses an *electronic book system* [see Column 1, Lines 13-20 →

DeRose discloses this limitation, as clearly indicated in the cited text], *comprising:*

- *an electronic book, the electronic book including components of digital data that represent information* [see Figures 3-6, 12-15 and 22 → DeRose discloses this limitation, as clearly indicated in the cited text. Moreover, an "electronic book" inherently includes "components of digital data that represent information" in that an electronic book is made up of "digital data" having "components" that "represent information."]; and
- *links among the components of the digital data* [see Figures 3-6, 12-15 and 22 → DeRose discloses this limitation in that the system includes links between the various components of the system illustrated in the cited figures];

wherein, when the links are activated, a first component is linked to a second component [see Figures 12, 14 and 22; see Column 15, Lines 43-47; see Column 22, Line 63 through Column 23, Line 36 → DeRose discloses this limitation in that, when a user clicks on a section of the electronic book in the table of contents, the system retrieves that section and the annotations associated with that section. The system subsequently displays the selected section and icons for the annotations associated with that section.]; *[and] wherein the first component is located in the electronic book* [see Figures 12 and 14; see Column 15, Lines 43-47 → DeRose discloses this limitation

in that the electronic book comprises a table of contents including user-selectable sections of the electronic book].

DeRose fails to expressly disclose:

- *[a] second component [that] is an network site including an address of one or more news groups related to the first component.*

Herz teaches a system for providing electronic documents and identifying desirable target objects related to the electronic documents [see Column 1, Lines 19-43
→ Herz teaches this limitation, as clearly indicated in the cited text], comprising:

- *a first component [that] is linked to a second component* [see Column 8, Line 50 through Column 9, Line 58 → Herz teaches this limitation in that the system comprises components that are linked to each other];

wherein the first component is located in the electronic [document] [see Column 8, Line 50 through Column 9, Line 58 → Herz teaches this limitation in that the system comprises online newspapers]; and *wherein the second component is an network site including an address of one or more news groups related to the first component* [see Column 8, Line 50 through Column 9, Line 58 → Herz teaches this limitation in that the system comprises news groups],

for the purpose of presenting target objects that are likely to be of interest to the user [see Column 1, Lines 28-35].

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in DeRose, to include:

- *[a] second component [that] is an network site including an address of one or more news groups related to the first component,*

for the purpose of presenting target objects that are likely to be of interest to the user, as taught in Herz.

Claim 108:

This claim corresponds to the subject matter recited in Claims 30 and 98. Thus, DeRose, in view of Herz, discloses/teaches every limitation of Claim 108 and provides proper motivation, as indicated in the above rejections for Claims 30 and 98.

Allowable Subject Matter

Claims 19-25 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, any outstanding rejections and/or objections to the claims must be obviated before the claims are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 19:

The prior art fails to disclose or suggest an electronic book system comprising the combination of recited limitations.

Claims 20-25:

These claims are dependent upon Claim 19 and thus include allowable subject matter.

Claim 47:

The prior art fails to disclose or suggest a method for linking electronic files to electronic books comprising the combination of recited limitations.

However, as indicated in the above rejection of Claim 30 under 35 U.S.C. 112, second paragraph, Claim 47 does not correspond to Claim 30. The examiner suggests the following amendment:

47. (currently amended) A method for linking electronic files to electronic books, comprising:

identifying a first selectable text element that is a section of [[the]]actual text in a first electronic book;

associating a first an electronic file with the first selectable text element, wherein the associating step creates a first an electronic link;

repeating the identifying and associating steps, the repeated steps thereby creating multiple electronic links, each electronic link having a corresponding selectable text element and a corresponding electronic file; and

activating the first electronic link by selecting the first selectable text element, the activating step causing the first electronic file to be displayed; and

providing a menu, wherein the menu includes a show-links menu, and wherein the show-links menu displays is capable of displaying all of the available corresponding electronic links associated with a selected one of the selectable text elements in the first electronic link book,

wherein the links menu displays all of the available corresponding electronic link types for a displayed page in the first electronic book, and, when a desired electronic link type is selected from the links menu, only the available corresponding electronic links of the selected link type are displayed.

This suggested amendment eliminates the “activation” step of Claim 30.

Therefore, all dependent claims should be amended accordingly, if necessary.

Response to Arguments

Applicant's arguments in support of Claims 1, 30, 80, 86, 103 and 109 filed 12/08/2006 have been fully considered but they are not persuasive.

Arguments in support of Claims 1, 30, 80, 86 and 103:

Applicant argues that DeRose fails to disclose a first component that is a piece of actual text of an electronic book, as recited in the claims, because the table of contents in DeRose is not a piece of “*actual text*” of the electronic book. See *Response – Page 18*, first full paragraph.

The examiner disagrees.

DeRose expressly discloses that a variety of mechanisms may be used for obtaining from a user a desired starting point from which rendering of a document may begin, including the well-known table of contents from which a selection of a document may be selected (see Figures 12 and 14; see Column 15, Lines 43-47). The table of contents is part of the electronic document. Thus, the table of contents comprises “*actual text*” of the electronic document.

Arguments in support of Claims 92, 93, 95, 98, 99, 109 and 111:

Applicant's arguments with respect to Claims 92, 93, 95, 98, 99, 109 and 111 have been considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH
February 28, 2007



Doug Hutton

Primary Examiner
Technology Center 2100